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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Werner KERZENDORF, et al.

Serial No.: 09/907,513

Group No.: 2121

Filed: July 17, 2001

Examiner: Ronald D. Hartman Jr.

For: SENSOR SYSTEM AND METHOD FOR DETERMINING SYSTEM STATES

Attorney Docket No.: U 013457-4

Director of the U.S. Patent and Trademark Office

P. O. Box 1450

Alexandria, VA 22313-1450

**PETITION TO EXERCISE SUPERVISORY AUTHORITY AND  
WITHDRAW THE HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181**

It is respectfully requested that the exercise of supervisory authority and the withdrawal of the holding of the abandonment be considered on the basis of the following submission:

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**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being:

**MAILING**

- ☒ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

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Signature

Date: June 2, 2005

JULIAN H. COHEN

(type or print name of person certifying)

### PROSECUTION HISTORY

On June 18, 2003, Examiner Hartman issued the first Official Action. The Examiner objected to claims 1 and 4 due to informalities. Claims 1-8 were allegedly rejected under 35 U.S.C. 112 second paragraph as being indefinite. It is stated in the Official Action that “the Examiner believes that examination based on prior art is not feasible”. Additionally, it is stated that “the Examiner believes that if he does not adequately understand the intended meaning of the pending claims, an undue burden would be placed on the examiner is [sic] he was required to do a search with regards to the prior art of record”. The Examiner indicated that “all art rejections will held [sic] in abeyance until such time as the applicant has drafted claims that are clear and adequately claim the intended invention”.

Applicants submitted a response to the first Official Action on October 20, 2003. In that response, claims 1-8 were canceled and claims 9-28 were added in order to overcome the Examiner’s objections and assist the Examiner to examine the application on its merits.

On May 3, 2004, Examiner Hartman issued the second Official Action. Various claims were rejected under 35 U.S.C. 103(a) while claims 11-12 and 21-22 were indicated as containing allowable subject matter. Although this was the first Action based on merits, the Action was made FINAL.

In response to the second Official Action, applicants submitted an amendment under the expedited procedure for after-final amendments under 37 C.F.R. 1.116 on August 31, 2004. In the amendment, claims 1-8 remained canceled; claim 9 was amended; claim 16 was

canceled; and claim 29 was added. Applicants completed the priority claim under 35 U.S.C. 119, thereby claiming a priority date that precedes the effective date of the cited publication (Locke) and avoids the Examiner's rejection under 35 U.S.C.103(a). Applicants also requested that the Examiner withdraw the finality of the rejection of May 3, 2004 as that action was the first action on the merits and it was the first time that applicants were apprised of the cited art. Accordingly, this was the first opportunity that applicants had to respond to an art rejection.

On November 3, 2004 (more than two months since the filing of the response to the second Official Action, and on the last day of the six-month term of the second Official Action), Examiner Hartman issued an Advisory Action in response to the amendment filed August 31, 2004. In the Advisory Action, it is indicated that "in the communication to the Office, filed on 9/7/2004, two sets of claims were presented; one set for claims 1-11 and another set for claims 9-29. Since claims 1-8 were already canceled by the applicant, the first set (claims 1-11) is an improper attempt at brining claims back into prosecution after FINAL, and therefore these claims will not be treated, nor entered". There is absolutely no basis for this statement because claims 1-8 were canceled, and there were only one set of claims, namely, claims 9-15 and 17-29 were presented in the amendment.

It is further noted that the Advisory Action does not address applicants' request to withdraw the finality of the rejection of May 3, 2004.

### DISCUSSION OF PROSECUTION HISTORY

MPEP 706.07 states that “Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.” (emphasis added)

Furthermore, MPEP 706.07(a) states that “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” (emphasis added)

Since the Examiner clearly did not examine the application on the merits in the first Official Action, the finality of the second Official Action is premature.

Additionally, MPEP 714.13 states that “Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection should

be mailed within 30 days of the date the amendment is received by the Office." (emphasis added)

Accordingly, the Examiner failed to timely act on the second response which was properly filed under the expedited procedure.

### CONCLUSION

Since the finality of the second Official Action was premature, the finality of that Official Action should have been withdrawn by the Examiner. Had the Examiner done so, applicant would not have been bound by the six-month term of the second Official Action because a response was properly filed within the statutory term for reply.

It is also noted that the amendment in response to the second Official Action was a *bona fide* attempt and a *prima facie* case for placing the application into condition for allowance by virtue of establishing a priority date that precedes the date of the cited reference and by adopting the allowable subject matter indicated by the Examiner. Accordingly, there are reasons to believe that the amendment would have placed the application into condition for allowance but for the Examiner's failure to consider the right set of claims (see Examiner's comments in the Advisory Action).

Since the Examiner failed to timely respond to the second response and failed to address the applicants' request to withdraw the finality of the second Official Action, and because the Examiner has erroneously referred to "phantom" claims 1-11 as grounds for

failing to consider the second response on its merits, it is respectfully requested that the holding of the abandonment be withdrawn, the second response be entered, and the application be allowed.

If any fees are required, please charge Account No. 12-0425.

Respectfully submitted,



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